

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. HERRMAN, RONALD A. MEYER,
DOUGLAS R. STITT and ROBERT L. WOODARD

Appeal No. 1999-1169
Application No. 08/442,441

HEARD: August 16, 2000

Before CALVERT, McQUADE and JENNIFER D. BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

James A. Herrman et al. appeal from the final rejection of claims 2 through 21 and 36 through 57. Claims 22 through 34, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

The subject matter on appeal relates to a grinding wheel for finishing articles such as brake rotors, power steering pump rings and rotors, valve plates and the like. Claim 56 is illustrative and reads as follows:

56. A grinding wheel; comprising:

(a) disk-like base means for mounting the grinding wheel and having a substantially planar base surface;

(b) rim means extending from said disk-like base means and having a rim surface of predetermined width and which lies in a plane parallel to and spaced from said base surface; and

(c) abrasive means comprising a plurality of abrasive pieces each having a width substantially the same as said predetermined width of said rim surface with each said abrasive piece secured to said rim surface to form an array of abrasive pieces such that the width of each such abrasive piece is disposed to correspond to the width of said rim surface and so that said abrasive pieces are disposed along said rim surface with a predetermined open spacing therebetween all so as that said array of abrasive pieces covers a predetermined amount of said rim surface.

THE PRIOR ART

The references relied upon by the examiner as evidence of obviousness are:

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Hollstrom	2,442,129	May
25, 1948		
Keeleric	2,799,980	Jul. 23, 1957

THE REJECTION

Claims 2-21 and 36-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hollstrom in view of Keeleric.

Reference is made to the appellants' brief (Paper No. 13) and to the examiner's final rejection and answer (Paper Nos. 11 and 15) for the respective positions of the appellants and the examiner regarding the merits of this rejection.^{1,2}

DISCUSSION

We shall not sustain the examiner's 35 U.S.C. § 103(a) rejection of claims 2 through 21 and 36 through 57 as being unpatentable over Hollstrom in view of Keeleric. For the reasons expressed below, these claims are indefinite.

¹ Although the statements of the rejection in the final rejection and answer do not include claims 16 through 21, 36 through 42 and 50 through 55, the accompanying explanations indicate that the omission was inadvertent. The arguments advanced in the brief pertaining to these claims show that the appellants recognized the examiner's oversight and were not prejudiced thereby.

² The final rejection also included a 35 U.S.C. § 102(b) rejection based on Hollstrom which has since been withdrawn by the examiner (see page 3 in the answer).

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Therefore, the prior art rejection must fall because it is necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

NEW REJECTION

Claims 2 through 21 and 36 through 57 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would

be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. The purpose here is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Claims 56 and 57, the two independent claims on appeal, require the grinding wheel recited therein to include, inter alia, a rim surface of predetermined width and a plurality of abrasive pieces secured to or carried by the rim surface and each having a width "substantially the same as said predetermined width of said rim surface." In their brief, the appellants attach great importance to this limitation as a patentable distinction over the prior art; however, the use of the words "substantially the same" to define the relationship between the widths of the rim surface and the abrasive pieces poses a definiteness problem.

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Although § 112, ¶ 2, does not require exact precision in claim language, definiteness problems often arise when words of degree (such as "substantially the same") are used in a claim. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

When such words

are employed, it must be determined whether the underlying

specification provides some standard for measuring the degree, i.e., whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. Id. The appellants' specification provides no meaningful standard for measuring how close in dimension the widths of the rim surface and abrasive pieces have to be in order to be considered "substantially the same." This lack of guidance is exacerbated by seemingly inconsistent illustrations of the claimed width relationship in the appellants' drawings. For example, Figures 9 and 11 show a grinding wheel embodiment wherein the widths of the rim surface and abrasive pieces differ so significantly that they

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would not normally be considered as being "substantially the same." That the claim limitations at issue are nonetheless intended to cover this width relationship is evidenced by claims 20 and 54 which depend from claims 56 and 57, respectively, and are specifically drawn to the embodiment shown in Figures 9 and 11.

Thus, the meaning to be attributed to the limitations in claims 56 and 57 requiring the widths of the rim surface and the abrasive pieces to be "substantially the same" is unclear.

It

follows that claims 56 and 57, and claims 2 through 21 and 36

through 55 which depend therefrom, fail to set forth the metes and bounds of the appellants' invention with a reasonable degree of precision and particularity.

SUMMARY

The decision of the examiner to reject claims 2 through 21 and 36 through 57 under 35 U.S.C. § 103(a) is reversed; and a new 35 U.S.C. § 112, second paragraph, rejection of these claims is entered pursuant to 37 CFR § 1.196(b).

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
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